

REMARKS

This application has been carefully reviewed in view of the above-referenced Office Action, and reconsideration is requested in view of the following remarks.

Regarding the Double Patenting Rejection

Claims 1-3, 12-13, 19, 21-28 and 32-38 of the instant application are unpatentable over claims 1-29 of U.S. Patent No. 6,661,409, hereinafter the '409 reference, on the ground of nonstatutory obviousness-type double patenting. Claims 4-11, 14-18 and 29-?? are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-29 of '409 in view of Kuriyama et al. (U.S. 5,838,302).

While Applicant respectfully disagrees with the interpretation of the instant claims vis-à-vis the claims of the '409 reference, a timely filed terminal disclaimer is being filed herewith in the interest of moving forward the prosecution of this application. Applicant renews for the record the other differences noted between the instant claims and various claims of the '409 reference, noted in the November 21, 2006 response. Applicant moreover notes that in certain of the claims of the instant application, claim 1 for instance, "a display element" is a separate element from "a touch input screen" and thus the recitation in the claims that the display element is "operable to display one or more of recognized text and digital ink" makes it clear that the display of digital ink in the display element is different from the display of handwritten ink in a touch input area as shown in the '409 reference.

Regarding the Rejections Under 35 U.S.C. §102/103

Claims 1-3, 19, 21-22, 24-28, and 32-38 are rejected under 35 USC 102(e) as being anticipated by Demartines et al. reference of record, the '409 patent referenced above. Claim 4 is rejected under 35 USC 102(b) as being anticipated by Kuriyama et al. (US 5,838,302). Claims 4-11, 14-18 and 29-31 are rejected under 35 USC 103(a) as being unpatentable over the Demartines et al. '409 patent in view of '302. Claims 12 and 13 are rejected under 35 USC 103(a) as being unpatentable over '409. Claim 23 is rejected under 35 USC 103(a) as being unpatentable over '409 in view of Lui et al (US 6,256,009). Applicant respectfully traverses these grounds.

The terminal disclaimer filed herewith removes the '409 reference as a valid basis of a 102(e) or 103 reference. Moreover, Applicant respectfully submits that the amendments made to the various independent claims clarifies a distinction over the '409 reference.

The '409 reference, a commonly assigned patent to the instant application, does not teach, suggest or anticipate displaying digital ink in a display element that is an element claimed separate from a touch input screen as recited in one or more of the claims. The '409 reference only teaches displaying recognized text in a display area separate from a touch input screen and thus does not meet the recitation of recognized text in a text recognition mode and digital ink in an ink only mode, as recited in various of the amended independent claims.

Arguments put forth in the remarks filed November 21, 2006 are repeated here for the Examiner's convenience. The instant specification discusses at length digital ink displayed in display area 105, as being separate from text generated by a recognition element that may also be displayed in display area 105. The examiner is respectfully directed to page 4, lines 1-6; page 8, lines 18-21, 26-28; page 17, lines 15-21; page 18, lines 10-14. Conversion of written input to digital ink is further discussed at page 18, line 16 to page 19, line 9; and page 19, lines 11-18. Digital ink options, shown in Figure 3, and including digital ink modification in the display area are discussed at page 11, lines 9-13; page 12, lines 6-19; and page 20, line 17 to page 21, line 5. Directly displaying the written input as digital ink is discussed at page 13, lines 1-3; page 14, lines 14-16; page 16, lines 1-3; and page 17, lines 15-21. Toggling between an ink only mode and a text recognition mode (the only mode discussed in the '409 patent) is explored at page 20, lines 10-17, as well as the options (and/or) being discussed at page 10, line 25 to page 11, line 6.

The '409 reference, conversely, teaches only display of recognized text after it has been processed by a recognition element or engine. In '409, digital ink refers to the written input being displayed in the input area 104, not display area 105. Please refer to column 2, lines 55-61; column 3, lines 53-56, etc. Column 3, line 22, recites "if recognition is included" but there is no teaching, other than recognition to generate recognized text, of what could be displayed in area 105.

Concluding Remarks

In light of the foregoing reasons and the amendments to the independent claims to better clarify the subject matter of the invention, Applicant respectfully asserts that the remaining claims define patentable subject matter over the art of record.

The undersigned additionally notes that other distinctions may exist between the cited art and the claims, and reiterates the distinctions previously discussed in the prior response. In view of the clear distinctions pointed out above, further discussion is believed to be unnecessary at this time. Failure to explicitly address each point raised in the Office Action should accordingly not be viewed as accession to the Examiner's position or an admission of any sort.

In view of this communication, all claims are believed to be in condition for allowance and such is respectfully requested at an early date. If further matters remain to be resolved, the undersigned respectfully requests the courtesy of an interview. The undersigned can be reached at the telephone number below.

Respectfully submitted,
/Renee' Michelle Leveque/
Renee' Michelle Leveque
Registration No. 36,193
Leveque Intellectual Property Law, P.C.
221 East Church Street
Frederick, MD 21701
301-668-3073